

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT**(Under 37 CFR 1.97(b) or 1.97(c))**

Docket No.

13095

In Re Application Of: **Robert Harris**

JUL 08 2004

Serial No.

09/938,677

Filing Date

August 24, 2001

Examiner

David Lukton

Group Art Unit

1653

Title: **NEW USES FOR AMINO ACID ANTICONVULSANTS**

Address to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

37 CFR 1.97(b)

1. ☐ The Information Disclosure Statement submitted herewith is being filed within three months of the filing of a national application other than a continued prosecution application under 37 CFR 1.53(d); within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; before the mailing of a first Office Action on the merits, or before the mailing of a first Office Action after the filing of a request for continued examination under 37 CFR 1.114.

37 CFR 1.97(c)

2. ☒ The Information Disclosure Statement submitted herewith is being filed after the period specified in 37 CFR 1.97(b), provided that the Information Disclosure Statement is filed before the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application, and is accompanied by one of:

☒ the statement specified in 37 CFR 1.97(e);

OR

☐ the fee set forth in 37 CFR 1.17(p).

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
(Under 37 CFR 1.97(b) or 1.97(c))

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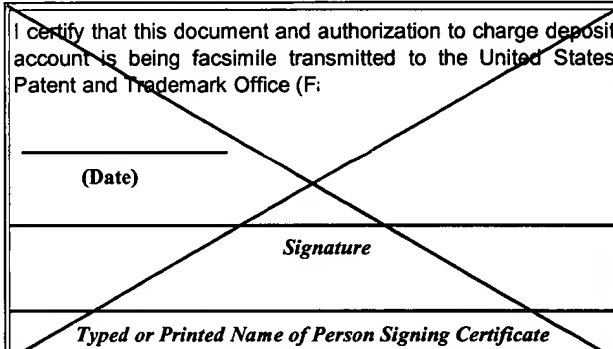
NEW USES FOR AMINO ACID ANTICONVULSANTS

Payment of Fee

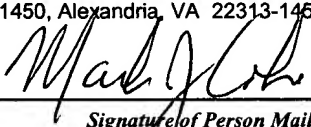
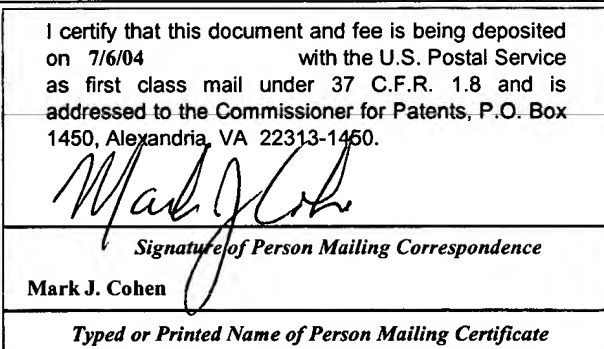
(Only complete if Applicant elects to pay the fee set forth in 37 CFR 1.17(p))

- ☐ A check in the amount of _____ is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. **19-3886/RCT** as described below.
- ☐ Charge the amount of _____
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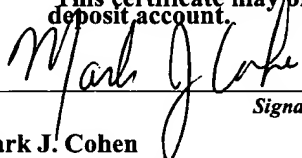
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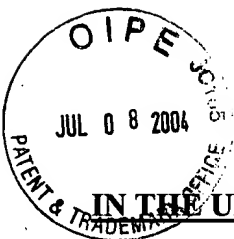
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Signature

Dated: July 6, 2004

Mark J. Cohen
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Robert Harris

Examiner: David Lukton

Serial No.: 09/938,677

Art Unit: 1653

Filed: August 24, 2001

Docket: 13095

For: NEW USES FOR AMINO ACID
ANTICONVULSANTS

Dated: July 6, 2004

Confirmation No.: 2566

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

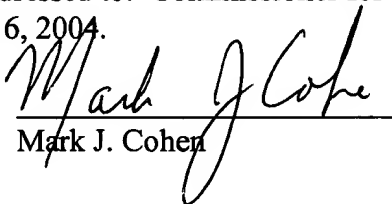
In accordance with 37 C.F.R. §§1.97 and 1.98, it is requested that the following references, which are also listed on the attached Form PTO-1449, be made of record in the above-identified case.

1. United States Patent No. 5,773,475, issued June 30, 1998;
2. United States Patent No. 5,654,301, issued August 5, 1997;
3. Parsons, et al., "Modulation of NMDA receptors by glycine – introduction to some basic aspects and recent developments", Amino Acids, 14: 207-216 (1998);

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 6, 2004.

Dated: July 6, 2004


Mark J. Cohen

4. Wlaz, et al., "Anticonvulsant effects of eliprodil alone or combined with the glycine_B receptor antagonist L-701,324 or the competitive NMDA antagonist CGP 40116 in the amygdala kindling model in rats", Neuropharmacology, 38: 243-251 (1999); and
5. Ebert, et al., "Anticonvulsant effects by combined treatment with a glycine_B receptor antagonist and a polyamine site antagonist in amygdala-kindled rats", European Journal of Pharmacology, 322: 179-184 (1997).

These references were cited in a Search Report dated May 12, 2004 received from the European Patent Office. It is to be noted that the Search Report lists eleven (11) items. However, the following items were previously submitted in an Information Disclosure Statement dated December 18, 2002.

United States Patent No. 5,378,729, issued January 3, 1995;

International Publication No. WO 99/43309, published September 2, 1999;

Kohn, et al., "Synthesis and Anticonvulsant Activities of α -Heterocyclic α -Acetamido-N-benzylacetamide Derivatives", J. Med. Chem., 36: 3350-3360 (1993);

Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", Bioorganic & Medicinal Chemistry, 7: 2381-2389 (1999);

Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C ^{α} , α -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", Int. J. Peptide Protein Res., 44: 85-95 (1994); and

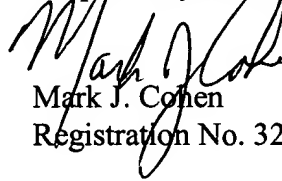
Billich, et al., "HIV proteinase inhibitors containing 2-aminobenzylstatine as a novel scissile bond replacement: biochemical and pharmacological characterization", Antiviral Research, 25: 215-233 (1994).

Since the latter six citations were previously made of record, it is deemed not necessary to make them of record again or to resubmit copies to the United States Patent and Trademark Office.

Applicant is submitting copies of the above-cited references 1-5, together with a copy of the Search Report. The relevance of the above-identified references has been described in the Search Report.

Further, the undersigned hereby states that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. Therefore, no fee is required.

Respectfully submitted,




Mark J. Cohen

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MJC:lf

Form PTO-1449 U.S. DEPARTMENT OF COMMERCE (REV. 7-80) PATENT AND TRADEMARK OFFICE				Atty. Docket No. 13095		Serial No. 09/938,677	
LIST OF PRIOR ART CITED BY APPLICANT (Use several sheets if necessary)				Applicant Robert H. Harris			
				Filing Date August 24, 2001		Group Art Unit 1653	



U.S. PATENT DOCUMENTS							
EXAMINER INITIAL*		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (if appropriate)
	AA	5,773,475	6/30/98	Kohn			
	AB	5,654,301	8/5/97	Kohn, et al.			
	AC	5,378,729	1/3/95	Kohn, et al.			

FOREIGN PATENT DOCUMENTS							
		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION
							YES NO
		WO 99/43309	9/2/1999	PCT			

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)	
	Kohn H. et al., "Synthesis and anticonvulsant activities of α -heterocyclic α -acetamido-N-benzylacetamide derivatives", <i>Journal of Medicinal Chemistry, United States 29 October 1993, vol. 36, no. 22, pp. 3350-3360</i>
	Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", <i>Bioorganic & Medicinal Chemistry 7 (1999), pp. 2381-2389</i>
	Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C. α,α -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", <i>Int. J. Pept. Protein Res. 44. 1994, 85-95, XP001074241, , Page 85, column 1, paragraph 2, Page 86, column 1; example XIV</i>
	Billich, et al., "HIV proteinase inhibitors containing 2-aminobenzylstatine as a novel scissile bond replacement: biochemical. and pharmacological characterization", <i>Antiviral Research 25 (1994) pp. 215-233</i>
	Parsons, et al., "Modulation of NMDA receptors by glycine - introduction to some basic aspects and recent developments", <i>Amino Acids, 14: 207-216 (1998)</i>
	Wlaz, et al., "Anticonvulsant effects of eliprodil alone or combined with the glycine _B receptor antagonist L-701,324 or the competitive NMDA antagonist CGP 40116 in the amygdala kindling model in rats", <i>Neuropharmacology, 38: 243-251 (1999)</i>
	Ebert, et al., "Anticonvulsant effects by combined treatment with a glycine _B receptor antagonist and a polyamine site antagonist in amygdala-kindled rats", <i>European Journal of Pharmacology, 322: 179-184 (1997)</i>

EXAMINER	DATE CONSIDERED
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* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.